

REMARKS

Claims 1-44 are currently pending in the instant Office Action. Claims 1 to 44 have been cancelled and claims 45 to 73 have been added. There being no issue of new matter, entry of the foregoing amendments is respectfully requested.

In light of the Examiners 112 rejections applicant has submitted a new set of claims. The following chart tracks how the new claims correspond to the subject matter of the cancelled claims and where support can be found in the specification. The applicants response to the Examiner's specific rejections then follows.

Amendments in the claim set:

The original claims 2-5, 7-9, 11-25, 28, 30, 31 are cancelled.

Current claim	Comment
45	Based on formula I.1 of the description
46	former claim 6
47	defines R1, R2 as in description page 30, lines 15-18
48	defines R1, R2 as in description page 32 bottom
49	defines R14 as in description page 33, lines 1-6.
50	former claim 10
51	former claim 26 wherein X is defined as in description page 34, line 13
52	defines R3 as in description page 35, line 19
53, 54, 55	define U, V as in description page 54, lines 10-14
56	former claim 27
57	defines R11 as in description page 35, lines 24-25
58	defines R20 as in description, paragraph bridging pages 35-36

59	defines R20 as in description page 45, line 5-6
60	former claim 29 wherein those compounds not covered by the formula I.1 are cancelled
61-73	former claims 32-44

Claim Rejections under 35 USC 112, First paragraph

The Examiner rejected claims 1-8, 11-13, 15, 16, 20-22, 26-28, 32 and 44 for lack of enablement. The Examiner asserts that the specification enables the claims wherein:

- i. A and Y are phenyl or pyridyl not extensively substituted;
- ii. W is a bond
- iii. Z is an alkylene chain;
- iv. B is phenyl
- v. R1-R3 are not extensively substituted, or not forming a bridge or a ring with another variable.

The Examiner asserts that the specification does not provide enablement wherein:

- vi. A and Y are phenyl or pyridyl that are extensively substituted;
- vii. W and Z are other groups or extensively substituted;
- viii. B is another ring
- ix. R1 –R3 are extensively substituted.

While the applicant does not agree with the Examiners position on the subject matter that is not enabled in the interest of advancing prosecution on the case applicant presents base claim 45 which applicant believes falls within the scope of the subject matter that the Examiner states is enabled by the specification.

35 USC 112, Second paragraph

The Examiner rejected claims 1-3, 6, 9-11, 13, 20-23, 26-28, 32 and 44 for being indefinite on a number of grounds. Each of these grounds is taken in turn.

- a. The Examiner states that it is not clear what ring or ring system is formed by R1 and R2. In

the newly added claims applicant has defined substituents R1 and R2 according to particular formula with definite structure in a markush format.

- b. The Examiner objects to the use of Formula I having variables that are defined by other variables that can be further substituted. Applicant is unclear of the basis of this objection without a specific example to refer to. In the interest of advancing prosecution applicant submits base claim 45 which recites a more simplified general formula than in former claim 1.
- c. The Examiner asserts that in the last paragraph of claim 1 that it is unclear if the listed substituents are additional substituents on the variables themselves, or if they are substituents on the substituents of those variables. The last paragraph of claim 1 that the Examiner refers to has not been incorporated into the corresponding instant claim 45.
- d. The Examiner asserts that the limitation of “group which can be cleaved in vivo” is indefinite. This limitation has been removed from the newly submitted claims.
- e. The Examiner asserts that is not clear if R6 and R7 have the same definition as R8 and R9 or if R25 has the same definition as R26 and R27. Variables R8 and R9 are not included in the added claims. R25, R26 and R27 have the same definition in the added claims.
- f. The Examiner asserts that claim 13 lacks antecedent basis because it depends on claim 1, but recites groups such as 2-hydroxyethyl (etc.) which are not recited in claim 1. Applicant has cancelled claim 13.
- g. The Examiner asserts that the scope of R23 and R24 of formula 1-1 is not within the scope of X in claim 1. In the newly added claims R23 and R24 are independent of X.
- h. The Examiner objects to the use of the term “preferably” in 44. This claim has not been included in the newly added claims.
- i. The Examiner rejected claim 2-3, 6, 9-11, 13, 16, 20-23, 26-28, 32 and 44 as being dependent on claim 1 with indefinite limitations. The rejected claims have been cancelled

AMENDMENT
US APPLN. NO. 10/647,156

and the corresponding new claims have been drafted to address the limitations that the Examiner asserts exist in former claim 1.

Applicant has also drafted the instant method claims 65, 66, and 68-72 to recite the use of a “therapeutically effective amount of a compound according to claim 45 or a pharmaceutically acceptable salt thereof.”

Authorization for payment of fees for a two month extension of time for reply to the Office Action is hereby given. Is not believed that any other fees are required beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. §1.136(a) and any fees required therefore are hereby authorized to be charged to our Deposit Account No. 02-2955.

If any points remain at issue which can best be resolved by way of a telephonic or personal interview, the Examiner is kindly requested to contact the undersigned attorney at the local telephone number listed below.

Respectfully submitted,

/David Dow/

David A. Dow
Reg. No. 46,124

Patent Department
Boehringer Ingelheim Corp.
900 Ridgebury Road
P.O. Box 368
Ridgefield, CT 06877
Tel: (203) 791-6214
Date: January 10, 2007